

**UNITED STATES DEPARTMENT OF COMMERCE****Patent and Trademark Office**Address: COMMISSIONER OF PATENTS AND TRADEMARKS  
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(H)

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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08/808,827 02/28/97 GUNZBURG

W GSF97-01A

HM22/0517

EXAMINER

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BRUSCA, T

ART UNIT

PAPER NUMBER

1636  
DATE MAILED:

14

05/17/99

Please find below and/or attached an Office communication concerning this application or proceeding.

**Commissioner of Patents and Trademarks**

<b>Advisory Action</b>	Application No. <b>08/808,827</b>	Applicant(s) <b>Gunzburg et al.</b>
	Examiner <b>John S. Brusca</b>	Group Art Unit <b>1636</b>

**THE PERIOD FOR RESPONSE: [check only a) or b)]**

- a)  expires \_\_\_\_\_ months from the mailing date of the final rejection.
- b)  expires either three months from the mailing date of the final rejection, or on the mailing date of this Advisory Action, whichever is later. In no event, however, will the statutory period for the response expire later than six months from the date of the final rejection.

Any extension of time must be obtained by filing a petition under 37 CFR 1.136(a), the proposed response and the appropriate fee. The date on which the response, the petition, and the fee have been filed is the date of the response and also the date for the purposes of determining the period of extension and the corresponding amount of the fee. Any extension fee pursuant to 37 CFR 1.17 will be calculated from the date of the originally set shortened statutory period for response or as set forth in b) above.

Appellant's Brief is due two months from the date of the Notice of Appeal filed on 5/10/99 (or within any period for response set forth above, whichever is later). See 37 CFR 1.191(d) and 37 CFR 1.192(a).

Applicant's response to the final rejection, filed on 5/10/99 has been considered with the following effect, but is NOT deemed to place the application in condition for allowance:

The proposed amendment(s):

will be entered upon filing of a Notice of Appeal and an Appeal Brief.

will not be entered because:

- they raise new issues that would require further consideration and/or search. (See note below).
- they raise the issue of new matter. (See note below).
- they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal.
- they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: see attachment

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Applicant's response has overcome the following rejection(s):

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Newly proposed or amended claims \_\_\_\_\_ would be allowable if submitted in a separate, timely filed amendment cancelling the non-allowable claims.

The affidavit, exhibit or request for reconsideration has been considered but does NOT place the application in condition for allowance because:

See attachment

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The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.

For purposes of Appeal, the status of the claims is as follows (see attached written explanation, if any):

Claims allowed: none

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Claims objected to: none

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Claims rejected: 1, 5, 7-26, and 28-30

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The proposed drawing correction filed on \_\_\_\_\_  has  has not been approved by the Examiner.

Note the attached Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_

Other

**JOHN S. BRUSCA  
PATENT EXAMINER  
ART UNIT 1636**

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### **DETAILED ACTION**

1. The Applicants have argued that certain disclosed embodiments in which foreign genes are placed between two LTR sequences are not taught by the cited art, however the claimed invention does not have the limitations discussed in the Applicant's response.
2. The proposed Amendment will not be entered because claim 7 has been amended to be dependent on cancelled claim 6, and claim 13 has been amended to result in a grammatically incorrect sentence, and the independent claims 1 and 17 have been broadened by eliminating the limitation that a cell specific promoter is present, which raised new issues and would require further search. If the Amendment were entered, rejections of record under 35 U.S.C. § 112, second paragraph would be withdrawn except the rejections regarding the comma in line 7 of claim 7.
3. The receipt of the certified copy of the Danish priority paper Application No. 1017/94 and PCT Application No. PCT/EP95/03445. It is brought to the Applicant's attention that while the PCT application may be claimed under 35 U.S.C. § 119, in order to establish a chain of copendency the claim for the PCT/EP95/03445 must be claimed under 35 U.S.C. § 120 and the claim for domestic priority is defective as noted in the next paragraph.
4. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

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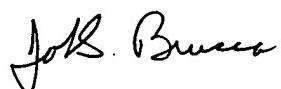
It does not state that the person making the oath or declaration in a continuation-in-part application filed under the conditions specified in 35 U.S.C. 120 which discloses and claims subject matter in addition to that disclosed in the prior copending application, acknowledges the duty to disclose to the Office all information known to the person to be material to patentability as defined in 37 CFR 1.56 which occurred between the filing date of the prior application and the national or PCT international filing date of the continuation-in-part application.

5. Certain papers related to this application may be submitted to Art Unit 1636 by facsimile transmission. For routine submissions the FAX number is (703) 308-4242. For FAX transmissions in cases in which the Examiner has been notified by phone to expect the transmission, the FAX number is (703) 305-7939. In such cases please call the Examiner at (703) 308-4231 at the time of transmission to expedite delivery of the fax. The faxing of such papers must conform with the notices published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6 (d)). NOTE: If applicant *does* submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to John S. Brusca, Ph.D. whose telephone number is (703) 308-4231. The examiner can normally be reached on Monday through Friday from 9 AM to 5 PM. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Elliott, Ph.D., can be reached at (703) 308-4003.

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Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



John S. Brusca, Ph.D.

*Primary*  
Patent Examiner